



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,540	07/26/2001	Michael Wayne Brown	AUS920010392US1	9050

43307 7590 10/23/2006

IBM CORP (AP)
C/O AMY PATTILLO
P. O. BOX 161327
AUSTIN, TX 78716

EXAMINER

PHILLIPS, HASSAN A

ART UNIT PAPER NUMBER

2151

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/915,540

Applicant(s)

BROWN ET AL.

Examiner

Hassan Phillips

Art Unit

2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 and 31-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-28 is/are allowed.
- 6) ☒ Claim(s) 29 and 31-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to communications filed August 7, 2006.

Claim Objections

2. The disclosure is objected to because the text on page 1 should be updated with the current status of the cited applications, such as: the current U.S. Patent Application Serial No. and filing date, or the current U.S. Patent No. and issue date. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 29 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 29 recites the limitation "said messaging session of entries" in 6th line of the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

6. In considering the amendments made to the preambles of claims 20 and 43, examiner has withdrawn the rejections to claims 20 and 43 under 35 U.S.C. 101.

Response to Arguments

7. Applicant's arguments, see pg.'s 29-43, filed August 7, 2006, with respect to the rejection(s) of claim(s) 29-48 under 35 U.S.C. 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Shur et al. (hereinafter Shur) U.S. Patent 7,031,326.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 29, 32, 33, 35, 36, are rejected under 35 U.S.C. 102(e) as being anticipated by Shur.

10. In considering claim 29, Shur discloses a method, in a particular client system from among a plurality of clients systems (103, 104, 110, 111, 115) enabled to communicate with one another in a messaging session facilitated by a messaging

server (120, 121) through at least one messaging channel via a network (101, 107, 108) for participating in a messaging session facilitated through a particular messaging channel, said method comprising the steps of: controlling output, at said particular client system, to a user participating in a messaging session of entries associated with said messaging session received via said messaging server from a plurality of users participating in said messaging session, (col. 4, lines 12-47); and in response to receiving a recording indicator for said messaging session from said messaging server, adjusting said output at said particular client system to distinguish a selection from among said plurality of message entries being recorded into a separate log by said messaging server, such that said user participating in said messaging session is notified when message entries posted by said user and said plurality of users are being recorded, (col. 6, lines 38-59).

11. In considering claim 32, Shur discloses in response to receiving a request to record by said user at said particular client system, transmitting a request to record a specified selection of entries associated with said messaging session to said messaging server, (col. 6, lines 38-59).

12. In considering claim 33, Shur discloses receiving, at said particular client system, from said messaging server, a recording approval request (i.e. login id and password) for recording a specified selection of entries associated with said messaging session, (col. 6, lines 38-59); presenting, at said particular client system, a request for

Art Unit: 2151

said user to approve said recording based on said recording approval request, (col. 6, lines 38-59); and in response to an indication of approval selected by said user, transmitting said indication of approval from said particular client system to said messaging server, (col. 6, lines 38-59).

13. In considering claim 35, Shur discloses adjusting, at said particular client system, a graphical output characteristic of said selection from among said plurality of entries being recorded (i.e. the stored session recorded at the specified date and time and retrieved on-demand) to distinguish said selection from among said plurality of message entries being recorded from another unrecorded selection of said plurality of message entries (i.e. parts of the session outside the range of the specified date and time), (col. 6, lines 38-59, also see col. 4, lines 25-32).

14. In considering claim 36, Shur discloses adjusting, at said particular client system, an audible output characteristic of said selection from among said plurality of entries being recorded (i.e. the stored session recorded at the specified date and time and retrieved on-demand) to distinguish said selection from among said plurality of message entries being recorded from another unrecorded selection of said plurality of message entries (i.e. parts of the session outside the range of the specified date and time), (col. 6, lines 38-59, also see col. 4, lines 25-32).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 31, 34, 37-54, are rejected under 35 U.S.C. 103(a) as being unpatentable over Shur in view of Applicant's Admitted Prior Art (AAPA).

17. In considering claim 31, although the teachings of Shur disclose substantial features of the claimed invention, they fail to expressly disclose: the messaging server comprising one of said plurality of client systems.

Nevertheless, it was well known in the art at the time of the present invention that servers could also function as clients, especially if the server functions as a personal computer. Applicant admits in the disclosure that as the Internet and telephony expand, the ease of communications between individuals in different locations continues to expand as well, (AAPA, pg. 2, lines 15-21). Applicant also admits computer systems and data communication equipment are used to support electronic communication from one person to another by e-mail, voice mail, unified messaging, instant messaging, or fax, (AAPA, pg. 2, lines 15-21).

Thus, if not implicit in the teachings of Shur, it would have been apparent to one of ordinary skill that the messaging server taught by Shur could comprise one of the

Art Unit: 2151

plurality of client systems. This would advantageously allow a user of the messaging server to communicate with other users, and thus participate in the messaging sessions, (AAPA, pg. 2, lines 15-21, Shur, col. 4, lines 12-47).

18. In considering claims 34, 40, and 46, Shur further discloses adjusting, at said particular client system, a characteristic of said selection from among said plurality of entries being recorded (i.e. the stored session recorded at the specified date and time and retrieved on-demand) to distinguish said selection from among said plurality of message entries being recorded from another unrecorded selection of said plurality of message entries (i.e. parts of the session outside the range of the specified date and time), (col. 6, lines 38-59, also see col. 4, lines 25-32).

Although the teachings of Shur disclose substantial features of the claimed invention, they fail to expressly disclose: the characteristic being a textual output.

Nevertheless, it was well known in the art at the time of the present invention that visual conferences as taught by Shur could include textual output. Applicant also admits in the disclosure that (similar to the teachings of Shur) instant messaging systems are typically utilized in the context of an Internet-supported application that transfers text between multiple Internet users in real time, (AAPA, pg. 2, lines 15-27).

Thus, if not implicit in the teachings of Shur, it would have been apparent to one of ordinary skill to modify the teachings of Shur to disclose the characteristic being a textual output. This would have advantageously allowed a user to record and playback

Art Unit: 2151

textual portions of the messaging session, (AAPA, pg. 2, lines 15-27, Shur, col. 6, lines 38-59).

19. In considering claims 37 and 43, Shur discloses a system and program residing on a tangible computer usable medium for participating in a messaging session, said system and program comprising: a particular client messaging system from among a plurality of clients systems (103, 104, 110, 111, 115), communicatively connected to a network (101, 107, 108), wherein said plurality of client systems are enabled to communicate with one another through a messaging session facilitated by a messaging server (120, 121) through a messaging channel via a network, (col. 3, lines 4-61);

Said particular client messaging system further comprising: means for controlling output to a user participating in a messaging session of entries associated with said messaging session received via said messaging server from a plurality of users participating in said messaging session, (col. 4, lines 12-47); and means for adjusting said output to distinguish a selection from among said plurality of message entries being recorded into a separate log by said messaging server, in response to receiving a recording indicator for said messaging session from said messaging server, such that said user participating in said messaging session is notified when message entries posted by said user and said plurality of users are being recorded, (col. 6, lines 38-59).

Although the teachings of Shur disclose substantial features of the claimed invention, they fail to expressly disclose: the messaging channel being an instant messaging channel.

Nevertheless, Shur does disclose the messaging channel supporting audio and visual Internet communications between multiple users in real time, (col. 4, lines 25-47). Applicant also admits in the disclosure that (similar to the teachings of Shur) instant messaging systems are typically utilized in the context of an Internet-supported application that transfers text between multiple Internet users in real time, (AAPA, pg. 2, lines 15-27).

Thus, if not implicit in the teachings of Shur, it would have been apparent to one of ordinary skill to modify the teachings of Shur to disclose the messaging channel being a instant messaging channel. This would have advantageously given users participating in the session options to communicate by text or voice, (AAPA, pg. 2, lines 15-27, Shur, col. 4, lines 12-47).

20. In considering claims 38 and 44, Shur discloses means for transmitting a request to record a specified selection of entries associated with said messaging session to said messaging server, in response to receiving a request to record by said user at said particular client system, , (col. 6, lines 38-59).

21. In considering claims 39 and 45, Shur discloses means for receiving a recording approval request (i.e. login id and password) from said messaging server for

Art Unit: 2151

recording a specified selection of entries associated with said messaging session, (col. 6, lines 38-59); and means for presenting a request for said user to approve said recording based on said recording approval request, (col. 6, lines 38-59); and means for transmitting said indication of approval to said messaging server, in response to an indication of approval selected by said user, (col. 6, lines 38-59).

22. In considering claims 41 and 47, Shur discloses means for adjusting a graphical output characteristic of said selection from among said plurality of entries being recorded (i.e. the stored session recorded at the specified date and time and retrieved on-demand) to distinguish said selection from among said plurality of message entries being recorded from another unrecorded selection of said plurality of message entries (i.e. parts of the session outside the range of the specified date and time), (col. 6, lines 38-59, also see col. 4, lines 25-32).

23. In considering claims 42 and 48, Shur discloses means for adjusting an audible output characteristic of said selection from among said plurality of entries being recorded (i.e. the stored session recorded at the specified date and time and retrieved on-demand) to distinguish said selection from among said plurality of message entries being recorded from another unrecorded selection of said plurality of message entries (i.e. parts of the session outside the range of the specified date and time), (col. 6, lines 38-59, also see col. 4, lines 25-32).

24. In considering claim 49, Shur discloses a user interface at a client system for controlling recording of messaging sessions facilitated by a messaging server (120, 121) through at least one messaging channel via a network (101, 107, 108) between a plurality of client systems (103, 104, 110, 111, 115), comprising: a selectable item for initiating recording by said messaging server of a log of a selection of message entries within a particular messaging session, (col. 6, lines 38-59); and a changing visual display of a plurality of message entries within said particular messaging session for distinguishing said recorded selection of message entries within said particular messaging session (i.e. the stored session recorded at the specified date and time and retrieved on-demand) from another unrecorded selection of said plurality of message entries within said particular messaging session (i.e. parts of the session outside the range of the specified date and time).

Although the teachings of Shur disclose substantial features of the claimed invention, they fail to expressly disclose: the changing display being textual.

Nevertheless, it was well known in the art at the time of the present invention that visual conferences as taught by Shur could include textual output. Applicant also admits in the disclosure that (similar to the teachings of Shur) instant messaging systems are typically utilized in the context of an Internet-supported application that transfers text between multiple Internet users in real time, (AAPA, pg. 2, lines 15-27).

Thus, if not implicit in the teachings of Shur, it would have been apparent to one of ordinary skill to modify the teachings of Shur to disclose the changing display being

textual. This would have advantageously allowed a user to record and playback textual portions of the messaging session, (AAPA, pg. 2, lines 15-27, Shur, col. 6, lines 38-59).

25. In considering claim 50, Shur discloses a selectable approval indicator (i.e. login id and password) for indicating approval to said messaging server of recording of a log of said selection of message entries, (col. 6, lines 38-59).

26. In considering claim 51, the combined teachings of Shur (col. 4, lines 12-47), and AAPA (pg. 2, lines 15-27), provide a means for said changing textual display to distinguish between topics within said particular messaging session. One of ordinary skill would combine the teachings of AAPA with Shur for reasons previously indicated in considering claim 49.

27. In considering claim 52, Shur discloses a selectable item (i.e. stop date field) for stopping recording by said messaging server of said selection of message entries, (col. 6, lines 38-59).

28. In considering claim 53, the teachings of Shur provide a means for pausing recording (i.e. buttons enabling the client to start the existing session, and the start and stop fields) by said messaging server of said selection of message entries, (col. 6, lines 38-59).

29. In considering claim 54, Shur discloses a graphical indicator (i.e. the stored session retrieved on-demand) of the current recording of said selection of message entries by said messaging server, (col. 6, lines 38-59).

Allowable Subject Matter

30. Claims 1, 3-28 are allowed. Examiner was unable to find prior art teachings that taught or suggested applicant's amended claims. Specifically, prior art teachings failed to teach or suggest in response to receiving a request to record a messaging session at said server system, detecting a separate authorization level of each user participating in said messaging session via one of said plurality of separate client systems, determining a selection of users from among a plurality of users at said plurality of separate client systems each with said separate authorization level within a particular authorization requirement for said particular messaging session, or submitting a separate approval request to each of said selection of said plurality of users.

Conclusion

31. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. "RealCast-Real-Time Service with IP Multicast", Firmeza et al. – discloses well known tools such as Visual Audio Tool (VAT), the Visual Conference Tool (VIC) and the Internet Protocol Television Tool (IPTV).

Art Unit: 2151

32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hassan Phillips whose telephone number is 571-272-3940. The examiner can normally be reached on Mon-Fri (8am-5pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on 571-272-3939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HP/
10/18/06


PATRICE WINDER
PRIMARY EXAMINER